

REMARKS

Claims 1-49 are pending in this application. Claims 1, 15, 20, 22, and 31 are independent. In light of the remarks contained herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

Examiner Interview

Applicants wish to thank the Examiner and his Primary for the interview conducted on December 2, 2003. During the interview, the parties agreed that the prior art references do not teach a position-coding pattern comprising a plurality of first symbols and an address-coding pattern comprising a plurality of second symbols as recited in claim 1. The parties additionally discussed claims 15 and 20. Applicants respectfully request that the Examiner consider these additional remarks when considering patentability of the pending claims over the prior art references.

**Claim 15 is Patentable Over
*Sekendur and Kusunuki et al.***

During the interview, the Examiner asserted that the references, in combination, teach means for converting a recorded image to at least one position and storing the position in the memory based on the position-coding pattern contained in the recorded image which codes at least one position and means for converting another recorded image to at least one character and

storing the character in the memory based on an address-coding pattern contained in the recorded image which codes at least one character. Applicants maintain their position that the references fail to teach or suggest these elements as recited in claim 15.

The preamble of claim 15 recites "An apparatus for electronically transmitting handwritten information written on a surface having a handwritten information area having a position-coding pattern imprinted thereon and an address area having an address-coding pattern imprinted thereon..." While *Sekendur*, *arguendo*, teaches a position-coding pattern, neither of the references, either alone or in combination, teach a position-coding pattern and an address-coding pattern.

Furthermore, neither of the references, either alone or in combination, teach a surface having a handwritten area having a position-coding pattern imprinted thereon and an address area having an address-coding pattern imprinted thereon. As the body of the claim refers to the position-coding pattern and the address-coding pattern, thus relying on the preamble to provide proper antecedent basis, the preamble must be afforded patentable weight. A preamble limits the invention if it recites essential structure or steps, or if it "necessary to give life, meaning, and vitality" to the claim. The courts have provided some guideposts discussing the preamble's effect on claim scope. For example, dependence on a

particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates reliance on both the preamble and claim body to define the claimed invention. See *Catalina Marketing International, Inc. v. Coolsavings.com, Inc.*, 52 USPQ2d 1781 (Fed. Cir. 2002). As neither of the references teach a surface having a position-coding pattern imprinted thereon and an address-coding pattern imprinted thereon, claim 15 is patentable over the references as cited by the Examiner.

It is respectfully submitted that the elements discussed above appear in the preamble of claim 20. Thus, claim 20 is patentable over the references cited by the Examiner based upon the reasons set forth above with regard to claim 15.

**Claims 22 and 31 Are Patentable Over
the Prior Art References**

During the interview, the parties discussed the position-coding pattern comprising a plurality of first symbols and an address coding pattern comprising a plurality of second symbols. It is respectfully submitted that claims 22 and 31 include recitations directed to a position-coding pattern in the form of a plurality of first symbols and an address coding pattern with a plurality of second symbols. These elements are similarly recited in independent claim 31. Based upon the discussions during the interview, it is respectfully submitted that independent claims 22 and 31 are

allowable over the cited references. As such, it is respectfully requested that the outstanding rejections be withdrawn.

New Claims

New claims 47-49 have been added by this Reply. It is respectfully submitted that these claims are allowable over the art cited by the Examiner.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Appl. No. 09/813,114


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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(Rev. 09/30/03)